

## **REMARKS**

### ***Specification***

The three paragraphs added through this Amendment were parts of the parent application, International Application PCT/EP99/05175, filed July 20, 1999, published in English with International Publication No. WO 00/05078 under PCT Article 21(2) (see, the section from the last paragraph on page 5 to the second paragraph on page 6).

The first paragraph on page 1 is amended to correct the typos. Attached hereto is a marked-up version of the changes made to the **specification** by the present amendment. The attached page is captioned "Version With Marking To Show Changes Made."

### ***Remaining Claims***

Twenty-One (21) claims (Claims 1 – 16 and 22-26) remain pending in this application through this Amendment. Claims 1, 3, 5-7, 12-14 and 16 have been amended herein. Supports for the amendment of claim 1 and for newly added claims 22-26 can be found on page 2, lines 5-20, on page 3, lines 6-19, and on page 5, lines 10-16. As explained in more detail below, Applicants have amended the claims to more clearly point out and distinctly claim the invention, and submits that all claims are now in condition for allowance. Attached hereto is a marked-up version of the changes made to the **claims** by the present amendment. The attached page is captioned "Version With Marking To Show Changes Made."

### ***Rejection of Claims under 35 USC §102(b)***

Claims 1-10 and 13 were rejected under 35 USC 102(b) as being fully anticipated by Kiyosaki JP 08-047784. The rejection over claims 1-10 and 13 is respectfully traversed for the following reasons.

Kiyosaki teaches a continuous process consisting of making blister containers, filling the blister containers, marking the blister container by a laser beam marking device, and then sealing the filled and marked blister containers (Drawing 1 and paragraph 0009). In Kiyosaki's process, the marking is achieved by laser-induced discoloring of PVC which is used as a material for making blister containers (see, e.g., Abstract and paragraphs 0004 and 0011). PVC is not a laminated film and does not comprises a metal film affixed to a plastic film. PVC film is used to make blister containers. In contrast to Kiyosaki, Applicants' invention is directed to laser marking of a laminated film, which comprises a metal film and a plastic film and which covers and seals a contact lens

container. According to Kiyosaki's teaching, it is advantageous not to use the laser marking approach in which the opaque ink layer of a plastic film is removed by a laser beam to produce visible marks, because of the high cost and complications associated with this approach (paragraph 0004). Therefore, Applicants submit that the invention as currently claimed are not fully anticipated by Kiyosaki, since the present invention as currently claimed does not contain all of the elements of Kiyosaki and since Kiyosaki does not contain all of the elements of the invention as currently claimed. Applicants respectfully request withdrawal of the 35 U.S.C. §102(b) rejection.

***Rejection of Claims under 35 USC §103(a)***

Claims 1-10, 13 and 15 were rejected under 35 USC 103(a) as being unpatentable over Kiyosaki JP 08-047784, in view of Edwards et al. '059. The rejection over claims 1-10, 13 and 15 is respectfully traversed for the following reasons.

As discussed above, Kiyosaki does not disclose nor suggest anything about laser marking of a laminated film which covers and seals a contact lens container. Kiyosaki does not anticipate nor render the remaining claims obvious.

Edwards et al. '059 does not disclose nor suggest anything about laser marking of a laminated film which covers and seals a contact lens container, and anything about creating marks on the laminated film by removing said plastic film down to said metal film without perforating the metal film or by changing the plastic film in a manner that a visible color change occurs, by means of a laser. Applicant respectfully submits that since the primary reference, alone or in combination with the secondary reference, does not provide any motivation or guidance to a person skilled in the art to make necessary changes to its disclosure to arrive at the present invention as currently claimed, the remaining claims (claims 1-16 and 22-26) are patentable over Kiyosaki in view of Edwards et al. '059. Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection.

Claims 1-13 and 15 were rejected under 35 USC 103(a) as being unpatentable over Kiyosaki JP 08-047784, in view of Edwards et al. '059 and Roy '771. The rejection over claims 1-13 and 15 is respectfully traversed for the following reasons.

Roy '771 discloses a laser drilling process capable of producing a plurality of holes in a pharmaceutical dosage form at high speed. Roy '771 does not disclose nor suggest anything about laser marking of a laminated film which covers and seals a contact lens container, and anything about creating marks on the laminated film by removing said plastic film down to said metal film without perforating the metal film or by changing the plastic film in a manner that a visible color change occurs, by means of a laser. Applicant respectfully submits that since the primary reference,

alone or in combination with the secondary references, does not provide any motivation or guidance to a person skilled in the art to make necessary changes to its disclosure to arrive at the present invention as currently claimed, the remaining claims (claims 1-16 and 22-26) are patentable over Kiyosaki in view of Edwards et al. '059 and Roy '771. Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection.

Claims 1-13 and 15 were rejected under 35 USC 103(a) as being unpatentable over Kiyosaki JP 08-047784, in view of Edwards et al. '059 and Roy '771, further in view of Bornfleth et al. '683. The rejection over claims 1-13 and 15 is respectfully traversed for the following reasons.

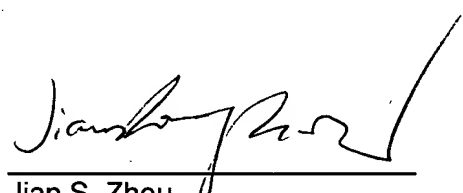
Bornfleth et al. '683 discloses an apparatus for temporary storage and transport of cigarettes between a maker and a packing machine. Bornfleth et al. '683 does not disclose nor suggest anything about laser marking of a laminated film which covers and seals a contact lens container, and anything about creating marks on the laminated film by removing said plastic film down to said metal film without perforating the metal film or by changing the plastic film in a manner that a visible color change occurs, by means of a laser. Applicant respectfully submits that since the primary reference, alone or in combination with the secondary references, does not provide any motivation or guidance to a person skilled in the art to make necessary changes to its disclosure to arrive at the present invention as currently claimed, the remaining claims (claims 1-16 and 22-26) are patentable over Kiyosaki in view of Edwards et al. '059 and Roy '771, further in view of Bornfleth et al. '683. Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection.

### **CONCLUSION**

For the foregoing reasons, Applicants submit that Claims 1-16 and 22-26 are patentable over the cited prior arts. Applicant respectfully requests reconsideration and withdrawal of the claim rejections set-forth in the Office Action and allowance of claims 1-16 and 22-26.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Thomas Hoxie, Novartis Corporation, Corporate Intellectual Property, One Health Plaza, Bldg. 430, East Hanover, NJ 07936-1080. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 19-0134.

Respectfully submitted,

  
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Date: January 17, 2003

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## Version with Markings to Show Changes Made

### In the specification:

Please amend the first paragraph on page 1 as follows:

This is a continuation of International Application No. PCT/EP99/05175, filed July[ 22]20, 1999 and published in English under PCT Article 21(2), which claim the benefit under 35 U.S.C. §119(a)-(d) or §365(b) of European Patent Application No. 98113623.7, filed July 22, 1998.

### In the claims:

Please amend claims 1, 3, 5-7, 12-14 and 16 as follows:

1. (Amended) A method for marking a laminated film [having a metal film and an plastic film, wherein said laminated film is useful for] that covers and seals a contact lens container, wherein said laminated film comprises a metal film and a plastic film affixed to the metal film, the method comprising the steps of:  
creating marks on the laminated film by removing said plastic film down to said metal film without perforating the metal film or by changing the plastic film in a manner that a visible color change occurs, [structurally modifying said plastic film] by means of a laser.
3. (Amended) The method of claim 1 wherein the [laminated] plastic film has a side facing towards the metal film and a side facing away from the metal film, and said plastic film has printed text on the side facing towards or away from the metal film.
5. (Amended) The method of claim 1 wherein the [film which forms the backing foil of] contact lens container is a blister pack and the laminated film is firmly welded with the blister pack to seal the blister pack.
6. (Amended) The method of claim 5 wherein several blister packs are covered and sealed by a [film] strip of the laminated film and form a blister strip.
7. (Amended) The method of claim 6 wherein the blister strip has [comprising] five blister packs [forming a blister strip].

12. (Amended) The method of claim 10 comprising the use of a CO<sub>2</sub>-laser with the wavelength 10.6  $\mu\text{m}$  and the focus point of the laser beam with a diameter of 1000–100  $\mu\text{m}$ , and preferably of 320  $\mu\text{m}$ .

13. (Amended) The method of claim [5] 6 comprising a stopper bar for the blister packs.

14. (Amended) The method of claim [5] 6 wherein the blister packs are transported within a packaging plant in at least two lines alongside one other.

16. (Amended) The method of claim [5] 6, wherein each blister pack comprises [comprising an ophthalmic lens, especially] a contact lens in blister packs.